

REMARKS

Claims 1-27 are pending in the present application. In the Office Action mailed October 20, 2006, the Examiner rejected claims 1-16 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner next rejected claims 1-27 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

In regard to the rejection of claim 1 under § 112, the Examiner mis-quoted claim 1 as reciting "... to indicate quality calculation" in stating that such language is only an intended result. The Examiner further reasoned that "there is no positive antecedent basis for limitation 'the shipment quality metric' because the obtaining the shipment quality metric is only intended result and not positive (sic) recited." *Office Action*, 10/20/06, pg. 2. First, Applicant notes that claim 1 does not recite the clause "to indicate quality calculation" and therefore is uncertain what the Examiner feels is intended result language. Applicant agrees that similar clauses such as "producing a difference value," "providing a shipment quality metric" and "to indicate process quality" are precisely intended results. However, such status does not warrant a rejection under § 112 for causing a lack of antecedent basis.

The elements of claim 1 which Applicant is left to guess are the subject of the Examiner's concerns fully comply with § 112 in that they give a definite name to the product of claimed step. For example, according to claim 1 the step of adding the "predetermined number of days" to the "difference value" provides a "shipment quality metric." Without giving a name to that produced by adding the predetermined number of days to the difference value (i.e. the shipment quality metric), claim 1 would become lexically over-complex and difficult to parse. Naming the product of a mathematical step or operation of a process helps a reader keep track of which variables are added, subtracted, etc. The Examiner, however, is suggesting that all "result" language should be ignored and that § 112 should be applied mechanistically to support rejections which would work to muddle a reader's understanding of claim language. *See* MPEP § 2173.02 ("Office policy is not to employ *per se* rules to make technical rejections").

There is no support to be found in the MPEP for ignoring specifically recited elements in order to produce a rejection based upon a lack of antecedent basis. The standard for rejections under § 112 is "whether 'those skilled in the art would understand what is claimed when the claim is read in light of the specification.'" MPEP § 2173.02 (citing *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986); *see also* MPEP § 2173.01 ("Applicant may use functional language ... or any style of expression or format of claim which makes clear

the boundaries of the subject matter for which protection is sought”). One skilled in the art would readily understand what is meant by performing an operation “producing a difference value,” “providing a shipment quality metric,” and “to indicate process quality.” Furthermore, since these products are first recited in claim 1 with the article “a” before being recited with definite articles, no antecedence problems exist. To find fault with the manner in which Applicant chose to phrase claim 1 would be contrary to the purpose of 35 U.S.C. § 112. MPEP § 2173.01 (“applicants are their own lexicographers); MPEP § 2173.02 (the fact that an examiner believes an alternative way to phrase a claim may be better is not a basis for rejection under § 112). Therefore, Applicant respectfully requests withdrawal of the § 112 rejection of claim 1 and all claims depending therefrom.

In a like manner, the Examiner made note of the clauses “to obtain a shipment quality metric” and “to determine overall shipment quality” in claim 11 as being intended result language. As discussed above with respect to claim 1, result language is not improper and cannot be ignored in an effort to artificially create antecedence problems. One skilled in the art would readily understand the meaning of these terms and would fully appreciate the invention from the present language of claim 11. Accordingly, Applicant respectfully requests withdrawal of the § 112 rejection of claim 11 and all claims depending therefrom.

In regard to the rejections under §101, the Examiner stated that the invention as described in claim 1 recites “a statistical calculation” and is not patentable subject matter because it is not concrete, tangible, or useful. *Office Action*, 10/20/06, pg. 6. In particular, the Examiner indicated that the method of claim 1 is not concrete “because without defining what this term means in the real world, one can not assume that the same result is achieved (i.e. concrete), not tangible because this term doses (sic) relate to anything in the real world, [and] not useful because the claim does not recite utility of the invention (i.e. no usefulness) or relates (sic) to real world application.” *Id.* Applicant disagrees because, quite simply, claim 1 is a process, which falls squarely within an enumerated category of 35 U.S.C. §101. The “practical application” standards the Examiner refers to were fashioned to address subject matter which does not clearly fall within a category that is expressly set forth in §101, not to further limit those categories already specifically enumerated in §101. *See State Street Bank & Trust v. Signature Financial*, 149 F.3d 1368, 1374-75 (Fed. Cir. 1999)(“it is improper to read limitations into §101 on the subject matter that may be patented where the legislative history indicates that Congress clearly did not intend such limitations”). In other words, the Examiner cannot add strings to what is already statutory. The Examiner cannot say some processes are patentable and others are not, just like an Examiner

cannot say some machines are not patentable. Machines and methods are two expressly enumerated categories for patentable subject matter under §101. The Examiner cannot further restrict what the legislature has provided. The MPEP states very clearly that “[i]f USPTO personnel can establish a *prima facie* case that a claim does not fall into a statutory category, the patentability analysis does not end there,” and then says “USPTO personnel must further continue with the statutory subject matter analysis as set forth below.” MPEP § 2106(IV)(B). Here, the claim clearly falls within one of the four enumerated categories (i.e. a process) and, as such, the MPEP directs that the analysis should stop at this point.

Regardless, even if such new tests were applicable to claims squarely falling within the statutory categories, claim 1 also clearly satisfies them. Claim 1 is not merely “a statistical calculation” as the Examiner purports, but rather recites a “method for measuring product shipment process capability” including steps of “maintaining a database” of real customer orders, products, and ship dates and processing the information in the database to indicate the quality of the actual product shipment processes. Such steps present a practical application in that, as claimed, they are applied to actual shipment orders from real world customers. Therefore, claim 1 does not recite merely abstract ideas or mathematical algorithms since any “statistical calculations” thereof are specifically applied to a practical endeavor – measuring the real capability of an actual product shipment process.

Furthermore, contrary to the allegations of the Examiner, the invention as recited in claim 1 produces a useful, concrete, and tangible result. According to the Examiner, to be “useful” a claim must “relate[] to [a] real world application” or “recite utility of the invention.” *Office Action*, 10/20/06, pg. 6. As set forth above, claim 1 is directed to an actual, real world application involving real orders and real customers. Moreover, the utility requirement does not necessitate that a utility (or a “specific, substantial, and credible use”) be recited in the claim. Rather, a utility is ordinarily described in the Specification. *See* MPEP § 2107.02 (“Upon initial examination, the examiner should review the specification to determine if there are any statements asserting that the claimed invention is useful for any particular purpose”). There is no requirement that an intended use or utility be wholly recited in a claim. Notwithstanding, both claim 1 and the specification of the present application clearly set forth a specific, substantial, and credible use for the invention, namely, to measure the capability or quality of an actual product shipping process by receiving, maintaining, and processing actual customer orders. *See, e.g., Specification*, ¶¶ 3, 24-28.

In addition, the invention as recited in claim 1 produces a tangible result in that it indicates to a user the quality of an actual shipment process. The requirement that a result be tangible does not necessitate a physical outcome. Rather, a tangible result can include displays and indications, or other knowledge-based results. *See* MPEP §2106(IV)(C)(2). Likewise, the invention as set forth in claim 1 also produces a concrete result. To have a concrete result, a process “must have a result that can be substantially repeatable or the process must substantially produce the same result again.” *Id.* With respect to claim 1 in particular, the Examiner merely paraphrased the test, stating without any reasoning that “one cannot assume the same result is achieved.” *Office Action*, 10/20/06, pg. 6. Such a statement confuses the burdens of proof in prosecution. It is incumbent upon the Examiner to establish that claims are not patentable, not to state that assumptions cannot be made. The Examiner has offered no proof to support an assertion that each time the process of claim 1 is performed, an indication of process quality will not result. As such, Applicant believes that the Examiner has failed to show that claim 1 lacks a useful, concrete, and tangible result.

Therefore, the present invention as recited in claim 1 not only falls squarely within a statutory category (a process), but also calls for a method that has a practical application which produces a useful, concrete, and tangible result (although such is not even necessary for an enumerated statutory category). As such, Applicant respectfully requests withdrawal of the rejection of claims 1-10 under §101.

The Examiner also rejected claim 17 under § 101, using similar misunderstandings. The Examiner characterized claim 17 by stating that “claim 17 recites ‘... compute and display a statistical value ...’” However, claim 17 recites, in part, a set of instructions that causes a computer to “maintain a database of data indicating an order number, a promise date, a request date, a max ship date, and a product category for each product” and to perform operations based upon “**a customer’s requested delivery date**” to “compute and **display** a statistical value providing an indication of process capability.” (Emphasis added). The Examiner divorced the invention from its real-world application and ignored nearly all the claim elements by characterizing claim 17 as computing and displaying merely “a statistical value.”

As discussed above, maintaining a database of actual customer order information and performing operations on the data thereof to get an indication of the capability or quality of a product shipment process is a practical application of the invention that achieves a useful, concrete and tangible result. Like the rejection of claim 1, the rejection of claim 17 fails to prove

that the invention as claimed is non-statutory subject matter. As such, Applicant respectfully requests withdrawal of the rejection of claim 17 and all claims depending therefrom.

With respect to claim 27, the Examiner stated that the claim “does not recite any result that is concrete, tangible, and useful of the process capability value.” *Office Action*, 10/20/2006, pg. 7. However, claim 27 is directed to “a computer readable storage medium,” having particular instructions stored thereon. Claim 27 is not cast as a process or method claim. Reciting an invention in the form of a computer readable storage medium has long been deemed to fall within the ambit of statutory subject matter. *See* MPEP § 2106.01 (when an invention is claimed as instructions “recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized”). Applicant also notes that while claims 11-16 (also directed to a computer readable storage medium) were included in the statement of the § 101 rejections, the Examiner did not specifically address the patentability of claims 11-16 under § 101, presumably for the foregoing reasons. Accordingly, Applicant requests withdrawal of the rejection of claims 1-16 and 27 under § 101.

Therefore, in light of at least the foregoing, and there being no other rejections pending, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-27.

Applicant appreciates the Examiner’s consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,

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